

Docket No.: HI-0021

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re Application of

Sang Hyun HAN

Application No.: 09/725,473

Confirm. No.: 1714

Filed: November 30, 2000

For: METHOD AND APPARATUS FOR TRANSMITTING AND RECEIVING A MESSAGE USING CALLER ID



Group Art Unit: 2643

Examiner: Barry W. Taylor

Customer No.: 34610


TRANSMITTAL OF APPEAL BRIEF

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop Appeal Brief-Patents
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Submitted herewith in triplicate is Appellant(s) Appeal Brief in support of the Notice of Appeal filed June 30, 2003. Enclosed is Check No.10328 for the Appeal Brief fee of \$320.00 and \$110.00 for a one month for extension of time fee. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
FLESHNER & KIM, LLP


Daniel Y.J. Kim

Daniel Y.J. Kim
Registration No. 36,186
Anthony H. Nourse
Registration No. 46,121

P.O. Box 221200
Chantilly, Virginia 20153-1200
703 502-9440 DYK/AHN:cre
Date: September 30, 2003

Please direct all correspondence to Customer Number 34610

Docket No.: HI-021

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

In re Application of	:	
	:	
Sang Hyun HAN	:	
	:	
Serial No.: 09/725,473	:	Group Art Unit: 2643
	:	
Confirm. No.: 1714	:	Examiner: Barry W. Taylor
	:	
Filed: November 30, 2000	:	Customer No.: 34610
	:	
For: METHOD AND APPARATUS FOR TRANSMITTING AND RECEIVING A MESSAGE USING CALLER ID		

APPEAL BRIEF

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop Appeal Brief-Patents
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed June 30, 2003.

I. INTRODUCTION

This is an appeal from an April 16, 2003 Office Action rejecting claims 1-11 and 13-35.

REAL PARTY IN INTEREST

The real party in interest for this appeal and the present application is LG Electronics, Inc. by way of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 011749, Frame 0237.

RELATED APPEALS AND INTERFERENCES

There are presently no appeals or interferences, known to Appellants, Appellants' representative, or the Assignee which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal.

STATUS OF THE CLAIMS

Claims 1-11 and 13-35 are pending in the application. The application was originally filed with claims 1-31. Claims 33-35 were added by a Reply filed on May 10, 2002, and claim 12 was canceled by a Preliminary Amendment filed on November 30, 2000.

Independent claim 1 stands finally rejected and is on appeal. In addition, claims 2-5, which depend from independent claim 1, stand finally rejected and are on appeal.

Independent claim 6 stands finally rejected and is on appeal. In addition, claims 7-11, which depend from independent claim 6, stand finally rejected and are on appeal.

Independent claim 13 stands finally rejected and is on appeal. In addition, claims 14-17, which depend from independent claim 13, stand finally rejected and are on appeal.

Independent claim 18 stands finally rejected and is on appeal. In addition, claim 19,

which depends from independent claim 18, stands finally rejected and is on appeal.

Independent claim 20 stands finally rejected and is on appeal. In addition, claims 21-30, which depend from independent claim 20, stand finally rejected and are on appeal.

Independent claim 31 stands finally rejected and is on appeal. In addition, claim 32, which depends from independent claim 31, stands finally rejected and is on appeal.

Independent claim 33 stands finally rejected and is on appeal. In addition, claims 34 and 35, which depend from independent claim 33, stand finally rejected and are on appeal.

STATUS OF AMENDMENTS

In response to an Office Action dated February 12, 2002, Applicants filed an Amendment on May 10, 2002, amending claims 1, 6, 13, 18, 20, and 31. In response to a Final Office Action dated July 26, 2002, Applicants filed a Reply dated October 16, 2002, arguing allowability. An Advisory Action was issued on November 5, 2002, which maintained the rejections. In response to the Advisory Action, Applicants filed a Request for Continued Examination (RCE) on January 27, 2003. Applicants simultaneously filed an Amendment on January 27, 2003, amending claims 1, 6, 13, 18, 20, and 31. A non-final Office Action was subsequently issued on April 16, 2003. In response to the April 16, 2003 Office Action, Applicants filed a Notice of Appeal on June 30, 2003. A copy of all pending claims is attached hereto as Appendix A.

II. SUMMARY OF THE INVENTION

A. General

The present invention relates to a system and method of transmitting and receiving a message using a caller ID. According to one preferred embodiment of the present invention, an advertisement message is transmitted to a subscriber telephone using caller ID. Specifically, when a ring signal is sent to a subscriber, an advertisement message and an identification of the advertiser are provided as caller ID data. Within the caller ID information is the message from the advertiser (who is a 3d party message sender), as well as identification of the 3d party message sender (as distinguished from the calling entity that actually transmits the message to the recipient).

As is known in the relevant art, the terms "caller ID data" and "caller ID message" have a specific meaning. "Caller ID data" indicates a data field of a caller ID message. Additionally, the caller ID message is a specific message type, that includes caller ID data, that is defined by the international standards. The caller ID message is typically transferred to a call recipient when a ring signal is generated.

According to one aspect of the preferred embodiment, when the ring signal is generated, the caller ID message having both an identification of the 3d party sender and a message from the 3d party sender is transmitted to the subscriber.

B. The Claimed Invention

1. Group I - Claims 1-5

Independent claim 1 recites an apparatus for transmitting and receiving a message using a caller ID, including a first communications device having an embedded circuit to receive, modulate, and transmit information from an information provider, the information comprising an advertisement message, a cable/mobile communication company switching device configured to receive the information from the first communications device and provide access to a communication network for the first communications device, the cable/mobile communication company switching device having an embedded circuit for demodulating the information and transmitting the information and at least one of a telephone number and name of the information provider as caller ID data, and a subscriber device configured to receive the information and the at least one of the telephone number and name of the information provider from the first communications device through the cable/mobile communication company switching device and the communication network as caller ID data when a ring signal is generated by the cable/mobile communication company switching device to the subscriber device, the subscriber device having an embedded circuit to demodulate the caller ID data, and a display unit to display the information and the at least one of the telephone number and name of the information provider.

Additional features of the claimed invention are found in dependent claims 2-5.

Claim 2 depends from claim 1, and recites that the subscriber device displays the

information and the identify of the sender on the display unit.

Claim 3 depends from claim 1, and recites that the information is a text message.

Claim 4 depends from claim 3, and recites that the text message is an advertisement from an advertisement service company.

Claim 5 depends from claim 1, and recites that the first communications device is an advertisement service company communications device that generates an advertisement as the information, and the subscriber device is an advertisement service subscriber communications device that receives the advertisements from the advertisement service company communications device.

2. Group II - Claim 6-11

Independent claim 6 recites a method for transmitting and receiving an advertisement message using a caller ID, including (a) providing an identification of at least one message recipient and an advertisement message to be transmitted to the at least one message recipient, the message comprising advertising information, (b) modulating the at least one message recipient's information, with the advertisement message and identification information of a message provider, the identification information including at least one of a telephone number and a name of the message provider, and (c) transmitting a ring signal to the at least one recipient to send the advertisement message and the message provider identification information to the at least one message recipient as caller ID data.

Additional features of the claimed invention are found in dependent claims 7-11.

Claim 7 depends from claim 6, and recites that the steps of modulating the inputted advertisement service subscribers information and advertisement message, and information on a caller (calling party) and demodulating the received advertisement message and caller information are performed using FSK modulation/demodulation.

Claim 8 depends from claim 6, and recites that steps (a) and (b) are performed while a character inputting unit for inputting the at least one message recipient's information and the message is in an on-hook state.

Claim 9 depends from claim 6, and recites that step (a) further comprises completing the inputting of the at least one message recipient's information and the message, while the character inputting unit is in the on-hook state.

Claim 10 depends from claim 6, and recites that step (c) further comprises occupying a telephone line and sending a ring signal to a corresponding one of the at least one message recipient when a prescribed button of the character inputting unit is keyed in, while the character inputting unit is in an off-hook state.

Claim 11 depends from claim 10, and recites that a state mode of the character inputting unit is changed from the off-hook state to the on-hook state after the completion of step (c).

3. **Group III - Claim 13-17**

Independent claim 13 recites a method for transmitting and receiving an advertisement message using a caller ID, including receiving a ring signal and a corresponding caller ID data including an advertisement message and caller information, the caller information including at least one of a telephone number and a name of the message provider, and demodulating the received advertisement message and caller information, displaying the demodulated caller information on a display section, displaying the advertisement message on the display section, and listing the displayed advertisement message contents to store the listed advertisement message contents in a memory, and identifying the stored advertisement message contents.

Additional features of the claimed invention are found in dependent claims 14-17.

Claim 14 depends from claim 13, and recites that the steps of modulating the inputted advertisement service subscribers information and advertisement message, and information on a caller (calling party) and demodulating the received advertisement message and caller information are performed using an FSK modulation/demodulation.

Claim 15 depends from claim 13, and recites that the contents of the advertisement message displayed on the display section are listed with respective icons to store them.

Claim 16 depends from claim 13, and recites that the contents of the advertisement message displayed on the display section are listed by the caller information or caller IDs to store them.

Claim 17 depends from claim 13, and recites that the contents of the advertisement message displayed on the display section are listed by the caller information or caller IDs to store them, and payment of charges for the reception of the advertisement message is automatically requested.

4. **Group IV - Claim 18 and 19**

Independent claim 18 recites a method for transmitting and receiving a message using a caller ID, including providing advertisement service subscriber information and an advertisement message, modulating the advertisement service subscriber information and the advertisement message and sender identification information identifying at least one of a telephone number and a name of a sender of the advertisement message, transmitting a ring signal and caller ID data to the advertisement service subscriber, the caller ID data including the advertisement message and the sender identification information, receiving the ring signal and the caller ID data containing the advertisement message and the sender identification information by the advertisement service subscriber and demodulating the received advertisement message and sender identification information, and displaying the sender identification information and the advertisement message on a display.

Additional features of the claimed invention are found in dependent claim 19.

Claim 19 depends from claim 18, and adds the feature of listing the displayed advertisement message contents to store the listed advertisement message contents in a memory, and identifying the stored advertisement message contents.

5. Group V - Claim 20-30

Independent claim 20 recites an apparatus for transmitting and receiving a message using caller ID, including an input circuit, to receive and modulate message data and an identification signal from a message sender, wherein the message data comprises an advertisement message from the message sender, and wherein the identification signal includes at least one of a telephone number and a name of the message sender, a communications circuit, coupled to receive and demodulate the modulated message data and receive the identification signal from the input circuit and generate a caller ID message including the message data and the identification signal, and a receiving terminal, coupled to receive the caller ID message including the message data and the identification signal from the communications circuit when a ring signal is received from the communications circuit.

Additional features of the claimed invention are found in dependent claims 21-30.

Claim 21 depends from claim 20, and recites that the communications circuit comprises a communications service provider that provides a communications channel between the input circuit and the receiving terminal.

Claim 22 depends from claim 21, and recites that the communications service provider is a telephone company.

Claim 23 depends from claim 20, and recites that the identification signal uniquely identifies the input circuit.

Claim 24 depends from claim 20, and recites that the input circuit comprises an input port for receiving the message data, a modulator to modulate the message data, and a modem to output the modulated data.

Claim 25 depends from claim 20, and recites that the communications circuit comprises an input port to receive the modulated data and the identification signal, a demodulator to demodulate the received message data, and a transmitter to transmit the received message data and identification signal.

Claim 26 depends from claim 25, and recites that the transmitter comprises a modulator to modulate the received message data and identification signal for transmission, and an exchange to establish a communication channel between the input circuit and the receiving terminal.

Claim 27 depends from claim 26, and recites that the exchange is a public switched telephone network.

Claim 28 depends from claim 26, and recites that the exchange is a wireless telephone network.

Claim 29 depends from claim 20, and recites that the receiving terminal comprises a display panel to display the message data and the identification of the input circuit.

Claim 30 depends from claim 20, and recites that the receiving terminal comprises a telephone and a caller ID terminal.

6. **Group VI - Claim 31 and 32**

Independent claim 31 recites a method for transmitting and receiving a message using a caller ID, including providing advertisement service subscriber information and an advertisement message by an advertisement message sender, modulating the advertisement service subscriber information and the advertisement message, and identification information of the advertisement message sender, the identification information including at least one of a telephone number and a name of the advertisement message sender, transmitting the modulated advertisement service subscribers information, the advertisement message, and the identification information, receiving and demodulating the transmitted advertisement service subscribers information, advertisement message, and identification information, modulating the demodulated advertisement message and identification information, and transmitting a ring signal and a corresponding caller ID data containing the modulated advertisement message and identification information to at least one advertisement service subscriber, receiving the transmitted ring signal and corresponding caller ID data containing the advertisement message and identification information, and demodulating the received advertisement message and

identification information, displaying the demodulated identification information and the contents of the demodulated advertisement message on a display.

Additional features of the claimed invention are found in dependent claim 32.

*Claim 32 depends from claim 31, and adds the feature of listing the displayed advertisement message contents to store the listed advertisement message contents in a memory, and identifying the stored advertisement message contents.

7. Group VII - Claim 33-35

Independent claim 33 recites method for receiving a message using a caller ID, including receiving a ring signal and a corresponding caller ID data from an information service provider, wherein the caller ID data comprises an identification of the information service provider and a text message from the information service provider, and at least one of displaying the caller ID data on a display screen and storing the caller ID data in memory.

Additional features of the claimed invention are found in dependent claims 34 and 35.

Claim 34 depends from claim 33, and recites that the information service provider is an advertiser and wherein the text message from the information service provider is an advertisement.

Claim 35 depends from claim 33, and recites that a communication company switching device receives the text message from the information service provider along with the identification of the information service provider and an identifier of at least one intended

recipient and establishes a call to the at least one intended recipient to transmit the caller ID data.

III. THE ISSUES AND REJECTIONS

Claims 1-5, 20-22, and 33-35 stand rejected under 35 U.S.C. § 102(e) over Cramer et al. (U.S. Patent No. 6,304,651) (hereinafter Cramer). Claims 6-11, 13, 14, 16-19, and 23-32 stand rejected under 35 U.S.C. § 103(a) over Cramer, in view of Isenberg et al. (U.S. Patent No. 5,570,295) (hereinafter Isenberg). Claim 15 stands rejected under 35 U.S.C. § 103(a) over Cramer, in view of Isenberg, and in further view of Stumm (U.S. Patent No. 5,768,528).

A. Issues

1. Does Cramer anticipate the subject matter of claims 1-5, 20-22, and 33-35 under 35 U.S.C. § 102(e);
2. Does Cramer, in view of Isenberg, render obvious the subject matter of claims 6-11, 13, 14, 16, 17, 23-28, 31, and 32 under 35 U.S.C. § 103(a); and
3. Does Cramer, in view of Isenberg, and in further view of Stumm render obvious the subject matter of claim 15 under 35 U.S.C. § 103(a).

IV. GROUPING OF CLAIMS

Claims 1-5 comprise Group 1, wherein claims 1-5 stand or fall together.

Claims 6-11 comprise Group 2, wherein claims 6-11 stand or fall together.

Claims 13-17 comprise Group 3, wherein claims 13, 14, 16, and 17 stand or fall together, and claim 15 stands or falls alone.

Claims 18 and 19 comprise Group 4, wherein claims 18 and 19 stand or fall together.

Claims 20-30 comprise Group 5, wherein claims 20-30 stand or fall together.

Claims 31 and 32 comprise Group 6, wherein claims 31 and 32 stand or fall together.

Claims 33-35 comprise Group 7, wherein claims 33-35 stand or fall together.

V. ARGUMENT

As demonstrated below, the rejections are based upon imputing to the references that which they do not disclose, teach, or suggest. Such is not a proper rejection.

A. Scope And Content Of The Prior Art

1. Cramer et al. (U.S. Patent No. 6,304,651)

Cramer relates to a method and system for downloading a file to a subscriber telephone. Specifically, a network resource locator (such as a URL) is provided to a telephone for downloading a file to the telephone. Thus, referring to Cramer Figure 1, a telephone 20 is coupled to a central office switch 22. A modified ring access server 16 is also coupled to the central office switch 22 through the central office service unit 18. Accordingly, the telephone 20 can receive FSK messages including a network resource indicator through a modified ring access initiated by the modified ring access server 16. See column 5, lines 7-11. Cramer further

discloses that the network resources to which the telephone is directed by the FSK message may provide advertising content. See column 17, lines 21-64.

The telephone 20 is further configured to establish communications with an Internet service provider 24 through the central office switch 22 in order to communicate with a Java applet provider 25, 360, or a content provider 26, 366. See column 5, lines 11-19. Accordingly, the modified ring access server 16 provides a location to a network resource from which the telephone can download prescribed content. See column 5, lines 19-26.

Cramer further discloses that the FSK messages may include caller ID information, but more particularly includes SRC messages sent from the central office service unit 18, which include the resource address information. Accordingly, the caller ID information and the SRC message are disclosed to be different and distinct messages. Thus, referring to Cramer Figure 3, the SRC message format is disclosed. Additionally, an SRA control message format is also disclosed. These messages include the URL for the network resource from which content will be downloaded. See column 6, lines 22-38.

Finally, Cramer discloses that an event parser receives an FSK message using an FSK receiver. It is specifically disclosed that the FSK message that is received includes the network resource locator, identifying the resource from which content will be downloaded. See column 11, lines 18-23.

Consequently, Cramer discloses specific and particular FSK messages, identified as SRC control messages and SRC messages, which include an address of a remote network resource

from which a telephone may download content. Additionally, Cramer discloses that another type of FSK message is caller ID information. Moreover, the FSK messages disclosed by Cramer do not themselves contain the information. Rather, the messages point to a location where the information can be downloaded.

2. Isenberg et al. (U.S. Patent No. 5,570,295)

Isenberg relates to a video system that captures telephone number data that has been encoded into video signals transmitted over a video network. Specifically, Isenberg teaches that a telephone number can be encoded into a video signal. A video system receives the video signal and extracts the telephone number data from the video signal. A telephone call can then be initiated using the extracted telephone number. Isenberg further teaches that the extracted data is captured by a set-top box or similar device that is capable of telephone communication. Using the set top box, the viewer of the video data can access the extracted phone number by signaling the set-top box to dial the captured telephone number, and thereby initiate a telephone call from the viewer to a service provider.

To extract the telephone number data, Isenberg teaches that the telephone number data is marked by an escape sequence that is encoded into the vertical blanking interval of at least one of the video frames of the video data when a program is recorded or transmitted.

3. **Stumm (U.S. Patent No. 5,768,528)**

Stumm relates to a client-server system for delivery of online information, and to a method for operating a server system adapted to provide information files to a plurality of subscribers over communications network. Hence, Stumm teaches a server system that is configured to provide information files to a plurality of subscribers over a network. Specifically, a plurality of publishers store various publishing material in a database server. The database server maintains a schedule containing information relating to predetermined downloading schedules for subscribers of the database server. The server transmits a set of predetermined data files to each requesting subscriber as authorized by a corresponding publisher, including each file's name, size and identification code in response to an information request from each one of the subscribers according to the schedule. Subscribers thus follow a predetermined download schedule to request information from the server and download the information accordingly.

B. **Arguments Regarding Each Issue**

1. **Issue 1: Claims 7, 8, 12, 13, and 23-26**

Claims 1-5, 20-22, and 33-35 stand rejected under 35 U.S.C. § 102(e) over Cramer. Because the asserted reference fails to disclose all of the claimed features, it is respectfully submitted that the rejections are improper and should be withdrawn.

Anticipation under Section 102 requires "the presence in a single prior art disclosure of all elements of a claimed invention arranged as in that claim." Carella v. Starlight Archery & Pro Line Co., 804 F.2d 135, 138, 231 U.S.P.Q. (BNA) 644, 646 (Fed. Cir. 1998) (quoting Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082, 1101, 227 U.S.P.Q. (BNA) 337, 350 (Fed. Cir. 1985)) (additional citations omitted). Moreover, to anticipate a claim, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383, 58 U.S.P.Q.2d (BNA) 1286, 1291 (Fed. Cir. 2001); Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d (BNA) 1001, 1010 (Fed. Cir. 1991); PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2d (BNA) 1618, 1624 (Fed. Cir. 1996).

Independent claims 1, 20, and 33 broadly recite features of a preferred embodiment. Cramer fails to disclose all of the claimed features, as required by Section 102. For example, Cramer fails to disclose at least a first communications device having an embedded circuit to receive, modulate, and transmit information from an information provider, the information comprising an advertisement message, a cable/mobile communication company switching device configured to receive the information from the first communications device and provide access to a communication network for the first communications device, the cable/mobile communication company switching device having an embedded circuit for demodulating the information and transmitting the information and at least one of a telephone number and name of the information provider as caller ID data, and a subscriber device configured to receive the

information and the at least one of the telephone number and name of the information provider from the first communications device through the cable/mobile communication company switching device and the communication network as caller ID data when a ring signal is generated by the cable/mobile communication company switching device to the subscriber device, the subscriber device having an embedded circuit to demodulate the caller ID data, and a display unit to display the information and the at least one of the telephone number and name of the information provider, as recited in claim 1.

Moreover, Cramer fails to disclose at least an input circuit, to receive and modulate message data and an identification signal from a message sender, wherein the message data comprises an advertisement message from the message sender, and wherein the identification signal includes at least one of a telephone number and a name of the message sender, a communications circuit, coupled to receive and demodulate the modulated message data and receive the identification signal from the input circuit and generate a caller ID message including the message data and the identification signal, and a receiving terminal, coupled to receive the caller ID message including the message data and the identification signal from the communications circuit when a ring signal is received from the communications circuit, as recited in claim 20.

Additionally, Cramer fails to disclose at least receiving a ring signal and a corresponding caller ID data from an information service provider, wherein the caller ID data comprises an identification of the information service provider and a text message from the information

service provider, and at least one of displaying the caller ID data on a display screen and storing the caller ID data in memory, as recited in claim 33.

According to one preferred embodiment of the present invention, an advertisement message is transmitted to a subscriber telephone using caller ID. Specifically, when a ring signal is sent to a subscriber, an advertisement message and the identification of the advertiser are provided as caller ID data.

Cramer relates to a method and system for downloading a file to a subscriber telephone and is described above.

As discussed above, Cramer discloses specific and particular FSK messages, identified as SRC control messages and SRC messages, which include an address of a remote network resource from which a telephone may download content. Additionally, Cramer discloses that another type of FSK message is caller ID information. Moreover, the FSK messages disclosed by Cramer do not themselves contain the information. Rather, the messages point to a location where the information can be downloaded. There is thus no disclosure of using a caller ID message to transmit the particular information content that is recited in the pending claims. For example, there is no disclosure of transmitting an advertisement message as caller ID data or sending a text message from an information service provider as caller ID data.

Additionally, as admitted by the Patent Office, Cramer "does not explicitly show identification information of a message provider." Office Action, page 4, paragraph 3. Each of independent claims 1, 20, and 33 recite that the caller ID data includes such identification. For

example, claim 1 recites "transmitting the information and at least one of a telephone number and a name of the information provider as caller ID data," claim 20 recites an identification signal that "includes at least one of a telephone number and the name of the message sender" and generating "a caller ID message including the message data and the identification signal," and claim 33 recites that "caller ID data comprises an identification of the information service provider and a text message from the information service provider." Consequently, as admitted by the Patent Office, Cramer fails to disclose all of the features of these claims.

For at least these reasons, Cramer fails to disclose all of the claimed features as required by Section 102. Claims 2-5 depend from claim 1, claims 21 and 22 depend from claim 20, and claims 34 and 35 depend from claim 33. These claims are allowable for at least the reasons discussed above with respect to the corresponding independent claims. Because the asserted reference does not disclose all of the claimed features, it is respectfully submitted that the rejection is improper and should be withdrawn.

2. Issue 2: Claims 6-11, 13, 14, 16, 17, 23-28, 31, and 32

Claims 6-11, 13, 14, 16, 17, 23-28, 31, and 32 stand rejected under 35 U.S.C. § 103(a) over Cramer, in view of Isenberg. Because the asserted combination of references fails to teach or suggest all of the claimed features, it is respectfully submitted that the rejections are improper and should be withdrawn. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 U.S.P.Q.2d (BNA) 1941 (Fed. Cir. 1992). Additionally, it is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

It is respectfully submitted that one of skill in the art would not have been motivated to selectively combine features of Cramer and Isenberg to produce the claimed system and method. Specifically, it is respectfully submitted that one of skill in the art would not have been motivated to modify the teachings of Cramer, which is designed specifically as a method of downloading content to a telephone by providing an URL of a location from which to download, by including elements from the video system with embedded telephone number as taught by Isengerg.

For example, it is respectfully submitted that Isenberg is non-analogous art, and therefore cannot be used as a basis for an obviousness type rejection under Section 103. It is well known that a video system, as disclosed in Isenberg, is non-analogous to a telecommunication network that is configured to provide caller ID data. It is thus respectfully submitted that because Isenberg is a non-analogous reference, it cannot be used as the basis of a rejection under section 103.

In addition, even if one of skill in the art were motivated to modify the devices shown in Cramer with the teaching of Isenberg, it is respectfully submitted that such a combination would still not result in or achieve the claimed invention.

For example, Cramer is discussed above, and fails to teach or suggest at least including an advertisement message and message provider/sender identification information as caller ID data. Isenberg, either alone or in combination with Cramer, also fails to teach or suggest at least this feature. For example, Isenberg teaches that a telephone number is encoded into a video signal. A video system extracts the telephone number data from the video signal based on an escape sequence. Additionally, a telephone call can be initiated by a set-top-box using the extracted telephone number. There is no teaching or suggestion of transmitting any messages using caller ID data. Consequently, it is respectfully submitted that prima facie case of obviousness cannot be made.

Thus, it is respectfully submitted that the combination asserted by the Office Action would not result in achieving the claimed device. For this additional reason, it is respectfully submitted that the combination of references is improper.

Claims 7-11 depend from claim 6, claims 14, 16, and 17 depend from claim 13, claim 19 depends from claim 18, claims 23-30 depend from claim 20, and claim 32 depends from claim 31. These claims are allowable for at least the reasons discussed above with respect to the corresponding independent claims.

For all the reasons given above, it is respectfully submitted that a prima facie case of obviousness cannot be made, and that it requires impermissible hindsight reconstruction, in view of Applicants' own teaching, to combine the references applied in the Office Action to achieve the claimed device. For at least these reasons, it is respectfully submitted that the Section 103 claim rejections are improper and should be withdrawn.

3. Issue 3: Claim 15

Claim 15 stands rejected under 35 U.S.C. § 103(a) over Cramer in view of Isenberg and in further view of Stumm. Because the combination of references fails to teach or suggest all of the claimed features, it is respectfully submitted that the rejection is improper and should be withdrawn. Claim 15 depends from claim 13, which is described above in conjunction with the combination of Cramer and Isenberg. As discussed above, the combination of Cramer and Isenberg is improper, and further fails to teach or suggest all the claimed features. Moreover, Stumm, either alone or in combination with Cramer and Isenberg, fails to teach or suggest all of the features, and further fails to teach or suggest the features which are neither taught nor suggested by the combination of Cramer and Isenberg.

For example, Stumm relates to a method for operating a server system adapted to provide information files to a plurality of subscribers over communications network, such as the Internet. Stumm thus fails to teach or suggest at least including an advertisement message and identification information as caller ID data. Moreover, the Patent Office appears to rely on

Stumm to teach the feature of an icon. Consequently, the combination of references fails to teach or suggest all the claimed features.

Stumm fails to teach or suggest at least including an advertisement message and identification information as caller ID data. Stumm further fails to teach or suggest any aspects of incorporating information into a caller ID data to be transmitted with a ring signal.

It is therefore submitted that a prima facie case of obviousness cannot be made and that the rejection is improper and should be withdrawn.

CONCLUSION

For all of the above reasons, Applicants respectfully request this honorable Board to reverse the rejections of claims 1-11 and 13-35.

Respectfully submitted,
FLESHNER & KIM



Daniel Y.J. Kim
Registration No. 36,186
Anthony H. Nourse
Registration No. 46,121

P.O. Box 221200
Chantilly, VA 20153-1200
703 502-9440
Date: September 30, 2003

APPENDIX

1. (Previously Amended) An apparatus for transmitting and receiving a message using a caller ID, comprising:

a first communications device having an embedded circuit to receive, modulate, and transmit information from an information provider, the information comprising an advertisement message;

a cable/mobile communication company switching device configured to receive the information from the first communications device and provide access to a communication network for the first communications device, the cable/mobile communication company switching device having an embedded circuit for demodulating the information and transmitting the information and at least one of a telephone number and name of the information provider as caller ID data; and

a subscriber device configured to receive the information and the at least one of the telephone number and name of the information provider from the first communications device through the cable/mobile communication company switching device and the communication network as caller ID data when a ring signal is generated by the cable/mobile communication company switching device to the subscriber device, the subscriber device having an embedded circuit to demodulate the caller ID data, and a display unit to display the information and the at least one of the telephone number and name of the information provider.

2. (Original) The apparatus of claim 1, wherein the subscriber device displays the information and the identify of the sender on the display unit.

3. (Original) The apparatus of claim 1, wherein the information is a text message.

4. (Original) The apparatus of claim 3, wherein the text message is an advertisement from an advertisement service company.

5. (Original) The apparatus of claim 1, wherein the first communications device is an advertisement service company communications device that generates an advertisement as the information, and the subscriber device is an advertisement service subscriber communications device that receives the advertisements from the advertisement service company communications device.

6. (Previously Amended) A method for transmitting and receiving an advertisement message using a caller ID, comprising:

(a) providing an identification of at least one message recipient and an advertisement message to be transmitted to the at least one message recipient, the message comprising advertising information;

(b) modulating the at least one message recipient's information, with the advertisement message and identification information of a message provider, the identification

information including at least one of a telephone number and a name of the message provider;
and

(c) transmitting a ring signal to the at least one recipient to send the advertisement message and the message provider identification information to the at least one message recipient as caller ID data.

7. (Original) The method of claim 6, wherein the steps of modulating the inputted advertisement service subscribers information and advertisement message, and information on a caller (calling party) and demodulating the received advertisement message and caller information are performed using FSK modulation/demodulation.

8. (Original) The method of claim 6, wherein steps (a) and (b) are performed while a character inputting unit for inputting the at least one message recipient's information and the message is in an on-hook state.

9. (Original) The method of claim 6, wherein step (a) further comprises completing the inputting of the at least one message recipient's information and the message, while the character inputting unit is in the on-hook state.

10. (Original) The method of claim 6, wherein step (c) further comprises occupying a telephone line and sending a ring signal to a corresponding one of the at least one message

recipient when a prescribed button of the character inputting unit is keyed in, while the character inputting unit is in an off-hook state.

11. (Original) The method of claim 10, wherein a state mode of the character inputting unit is changed from the off-hook state to the on-hook state after the completion of step (c).

12. Previously Canceled

13. (Previously Amended) A method for transmitting and receiving an advertisement message using a caller ID, comprising:

receiving a ring signal and a corresponding caller ID data including an advertisement message and caller information, the caller information including at least one of a telephone number and a name of the message provider, and demodulating the received advertisement message and caller information;

displaying the demodulated caller information on a display section;

displaying the advertisement message on the display section, and listing the displayed advertisement message contents to store the listed advertisement message contents in a memory; and

identifying the stored advertisement message contents.

14. (Original) The method of claim 13, wherein the steps of modulating the inputted advertisement service subscribers information and advertisement message, and information on a caller (calling party) and demodulating the received advertisement message and caller information are performed using an FSK modulation/demodulation.

15. (Original) The method of claim 13, wherein the contents of the advertisement message displayed on the display section are listed with respective icons to store them.

16. (Original) The method of claim 13, wherein the contents of the advertisement message displayed on the display section are listed by the caller information or caller IDs to store them.

17. (Original) The method of claim 13, wherein the contents of the advertisement message displayed on the display section are listed by the caller information or caller IDs to store them, and payment of charges for the reception of the advertisement message is automatically requested.

18. (Previously Amended) A method for transmitting and receiving a message using a caller ID, comprising:

providing advertisement service subscriber information and an advertisement message;

modulating the advertisement service subscriber information and the advertisement message and sender identification information identifying at least one of a telephone number and a name of a sender of the advertisement message;

transmitting a ring signal and caller ID data to the advertisement service subscriber, the caller ID data including the advertisement message and the sender identification information;

receiving the ring signal and the caller ID data containing the advertisement message and the sender identification information by the advertisement service subscriber and demodulating the received advertisement message and sender identification information; and

displaying the sender identification information and the advertisement message on a display.

19. (Original) The method of claim 18, further comprising listing the displayed advertisement message contents to store the listed advertisement message contents in a memory, and identifying the stored advertisement message contents.

20. (Previously Amended) An apparatus for transmitting and receiving a message using caller ID, comprising:

an input circuit, to receive and modulate message data and an identification signal from a message sender, wherein the message data comprises an advertisement message from the

message sender, and wherein the identification signal includes at least one of a telephone number and a name of the message sender;

a communications circuit, coupled to receive and demodulate the modulated message data and receive the identification signal from the input circuit and generate a caller ID message including the message data and the identification signal; and

a receiving terminal, coupled to receive the caller ID message including the message data and the identification signal from the communications circuit when a ring signal is received from the communications circuit.

21. (Original) The apparatus of claim 20, wherein the communications circuit comprises a communications service provider that provides a communications channel between the input circuit and the receiving terminal.

22. (Original) The apparatus of claim 21, wherein the communications service provider is a telephone company.

23. (Original) The apparatus of claim 20, wherein the identification signal uniquely identifies the input circuit.

24. (Original) The apparatus of claim 20, wherein the input circuit comprises an input port for receiving the message data, a modulator to modulate the message data, and a modem to output the modulated data.

25. (Original) The apparatus of claim 20, wherein the communications circuit comprises an input port to receive the modulated data and the identification signal, a demodulator to demodulate the received message data, and a transmitter to transmit the received message data and identification signal.

26. (Original) The apparatus of claim 25, wherein the transmitter comprises a modulator to modulate the received message data and identification signal for transmission, and an exchange to establish a communication channel between the input circuit and the receiving terminal.

27. (Original) The apparatus of claim 26, wherein the exchange is a public switched telephone network.

28. (Original) The apparatus of claim 26, wherein the exchange is a wireless telephone network.

29. (Original) The apparatus of claim 20, wherein the receiving terminal comprises a display panel to display the message data and the identification of the input circuit.

30. (Original) The apparatus of claim 20, when the receiving terminal comprises a telephone and a caller ID terminal.

31. (Previously Amended) A method for transmitting and receiving a message using a caller ID, comprising:

providing advertisement service subscriber information and an advertisement message by an advertisement message sender;

modulating the advertisement service subscriber information and the advertisement message, and identification information of the advertisement message sender, the identification information including at least one of a telephone number and a name of the advertisement message sender;

transmitting the modulated advertisement service subscribers information, the advertisement message, and the identification information;

receiving and demodulating the transmitted advertisement service subscribers information, advertisement message, and identification information;

modulating the demodulated advertisement message and identification information, and transmitting a ring signal and a corresponding caller ID data containing the

modulated advertisement message and identification information to at least one advertisement service subscriber;

receiving the transmitted ring signal and corresponding caller ID data containing the advertisement message and identification information, and demodulating the received advertisement message and identification information;

displaying the demodulated identification information and the contents of the demodulated advertisement message on a display.

32. (Original) The method of claim 31, further comprising listing the displayed advertisement message contents to store the listed advertisement message contents in a memory, and identifying the stored advertisement message contents.

33. (Previously Added) A method for receiving a message using a caller ID, comprising:

receiving a ring signal and a corresponding caller ID data from an information service provider, wherein the caller ID data comprises an identification of the information service provider and a text message from the information service provider; and

at least one of displaying the caller ID data on a display screen and storing the caller ID data in memory.

34. (Previously Added) The method of claim 33, wherein the information service provider is an advertiser and wherein the text message from the information service provider is an advertisement.

35. (Previously Added) The method of claim 33, wherein a communication company switching device receives the text message from the information service provider along with the identification of the information service provider and an identifier of at least one intended recipient and establishes a call to the at least one intended recipient to transmit the caller ID data.